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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/332,298	06/11/1999	YASUSHI ABE	31812	2750
116	7590	03/30/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			NGUYEN, NAM V	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/332,298

Applicant(s)

ABE, YASUSHI

Examiner

Nam V Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-24 is/are allowed.
- 6) ☒ Claim(s) 25-28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This communication is in response to applicant's response to an Amendment which are filed November 10, 2004.

An amendment to the claims 21 has been entered and made of record in the application of Abe for a "radio paging receiver and message erasing method" filed June 11, 1999.

Claims 1-28 and 30 are pending.

### ***Response to Arguments***

In view of applicant's amendment to amend the claims 21 to obviate the claim objection, therefore, examiner has withdrawn the objection.

Applicant's amendments to the rejected claims are insufficient to distinguish the claimed invention from the cited prior arts or overcome the rejection of said claims under 35 U.S.C § 102(e) and 103(a) as discussed below. Applicant's amendment and argument with respect to the pending claims 25-28 and 30, filed November 10, 2004, have been fully considered but they are not persuasive for at least the following reasons.

On page 16, third paragraph, Applicant's states that Claim 30 was rejected under 35 U.S.C. 103(a) over Katagiri (US# 6,058,290) was incorrect. Claim 30 was rejected under 35 U.S.C. 102(e) as being anticipated by Katagiri (US# 6,058,290).

On page 16, fourth paragraph, Applicant's arguments with respect to the invention in Katagiri does not teach or suggest that "inputting a character sequence designated by a user" and "retrieving from the storage device all of the messages that contain the character sequence designed in the step of inputting" is not persuasive. The claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

As defined by claim 1, the paging receiver with selective erasure of stored received messages of Katagiri teaches the step of decides whether or not a message (or messages) has been selected (or designated) from among the messages represented by the data pieces stored in the memory. When the message(s) has been designated, the program advances to the next step. Katagiri suggests that adding a predetermined code word (a predetermined signal) to a head of each data piece representing the designated message. As will be made clear later, the predetermined code word serves to inhibit the related data piece from being read out from the memory 27. Thus, a data piece having the predetermined code word undergoes pseudo erasure. The predetermined code word is also referred to as the read-inhibition code word. It is preferable that the predetermined code word, that is, the read-inhibition code word, denotes a predetermined character, for example, a character "x". After the step 103, the current execution cycle of the program segment ends (column 5 lines 1 to 27; see Figure 5). Katagiri discloses further that a first step 121 of the program segment feeds the display 25 with information about a message or messages represented by a data piece or data pieces which have the read-inhibition code word

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and which are stored in the memory 27. The step 121 controls the display 25 to indicate the information about the message or messages with the read-inhibition code word. Generally, the user monitors the indication of the information about the message or messages with the read-inhibition code word, and actuates the operation unit 26 to designate or select a message or messages from there among as an object to be exposed to cancel of pseudo erasure. After the step 121, the program advances to a next step 122 (col. 6 lines 1 to 16; see Figure 7). Clearly, Katagiri discloses that inputting a character sequence designated by a user and sequence character user designates which messages set associated with character sequence.

Applicant also argues that Katagiri does not teach that the user may choose a character sequence for designating the message. The claim does not suggest user choose the character sequence. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Katagiri discloses a sequence character user designates which messages set associated with character sequence and retrieving messages that contain this character sequence, then erasing all of the messages set to associate with character sequence(s).

On page 17, fourth paragraph, Applicant's arguments with respect to the invention in Katagiri can not be used for rejecting the present claims under 35 U.S.C. 103(a) is not persuasive.

Katagiri used for rejecting the present claims under 35 U.S.C. 103(a) is proper. Since the application of Abe for a "radio paging receiver and message erasing method" filed June 11, 1999, the rejection under 102(e)/103(a) is proper for application filed prior to November 29,

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1999 (see MPEP 706.02(I) (3)). 35 U.S.C. (103(c) was amended on November 19, 1999 as applicable for applications filed prior to November 19, 1999.

Therefore, the examiner maintains that the references cited and applied in the last office actions for the rejection of the claims are maintained in this office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 30 is rejected under 35 U.S.C. 102(e) as being anticipated by Katagiri (US# 6,058,290).

Referring to claim 30, Katagiri discloses a paging receiver with selective erasure of stored received messages as recited in claim 1. See Figures 1-8 and respective portions of the apparatus and method.

Katagiri discloses a message erasing method of a radio paging receiver (column 1 line 56 to column 2 line 3; see Figure 1) comprising the steps of:

Receiving messages (122) (i.e. by receiving section) via a radio transmission from a base station (not shown) of a radio paging system (column 3 lines 58 to 67; see Figure 1);

Storing the messages in a storage device (27) (i.e. a memory) of the radio paging receiver (column 4 lines 4 to 27);

Inputting a character sequence (i.e. a read-inhibition code word) designated by a user (i.e. a designated messages by a user of an operation unit) (column 4 lines 40 to 54; column 5 lines 11 to 27; column 6 lines 4 to 23; see Figures 2-5 and 7);

Retrieving from the storage device (27) all of the messages that contain the character sequence designated (i.e. a designated messages) in the step of inputting (column 6 lines 1 to 30; see Figure 7); and

Erasing all of the messages retrieved in the step of automatically retrieving messages (column 6 lines 31 to 57; see Figure 8).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-26 are rejected under 35 U.S.C. 103(a) as being obvious over Vanden Heuvel et al. (US# 5426,424) in view of Katagiri (US# 6,058,290).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Referring to claim 25, Vanden Heuvel et al. disclose a message erasing method comprising the steps of:



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Receiving a radio signal from a base station of a radio paging system (column 1 lines 11 to 15; see Figure 1);

Picking up one calling address or a plurality of calling addresses assigned to own receiver from the radio signal being received (column 4 lines 26 to 33);

Picking up message data corresponding to the calling address or the calling addresses from the radio signal being received (column 4 lines 48 to 52);

Storing message contained in the message data (column 4 lines 48 to 52);

Designating character sequences (column 5 lines 60 to 63);

Detecting wither or not the designated character sequences are contained in the stored messages (column 5 lines 63 to 66).

However, Vanden Heuvel et al. did not explicitly disclose that erasing concerned messages collectively, the concerned messages being those of the stored messages that contain the designated character sequences. Vanden Heuvel et al. disclose erasing designated data bases upon receiving an add/delete selective call message (column 9 lines 65 to 68).

In the same field of endeavor of radio paging receiver with selective erasure of stored received messages, Katagiri teaches that erasing concerned messages (i.e. designated messages) collectively, the concerned messages being those of the stored messages (i.e. messages in memory 27) that contain the designated character sequences (i.e. a command to indicate messages with a predetermined code word or character) (column 4 lines 47 to 59; column 6 lines 31 to 57; see Figure 8) in order to erase the selected designated messages from the memory in response to a requirement for actual erasion.

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One skill in the art would have recognized to erase the selected designated messages collectively in a memory of Katagiri in erasing designated data bases upon receiving an add/delete selective call message of Vanden Heuvel et al. because Vanden Heuvel et al. suggest that the need to modify a time that set by a user to delete old messages in the memory is so desired (column 8 lines 42 to 63) and Katagiri teaches that using an operation unit to erase selected designated messages from a memory that the selective call receiver is received from the base station (column 6 lines 31 to 57; see Figure 8) in order to improve memory space and to increase efficiency. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to erase the selected designated messages collectively in a memory of Katagiri in erasing designated data bases upon receiving an add/delete selective call message of Vanden Heuvel et al. with the motivation being to provide a radio pager transceiver capable of erasing the designated messages collectively to save the memory space and to increase operating efficiency.

Referring to claim 26, Vanden Heuvel et al. in view of Katagiri disclose a message erasing method according to claim 25, Katagiri discloses wherein the character sequences which are designated to collectively erase messages are input via a character sequence inputting means (26) (i.e. by an operation unit) (column 4 lines 47 to 62; column 6 lines 31 to 57; see Figures 1 and 8).

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Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanden Heuvel et al. (US# 5426,424) in view of Katagiri (US# 6,058,290) as applied to claims 25 or 26, and in further view of Murai (US# 5,239,679.)

Referring to claims 27-28, Vanden Heuvel et al. in view of Katagiri disclose a radio paging receiver according to claim 25 or 26 above. However, Vanden Heuvel in view of Katagiri did not clearly disclose wherein the message data which are picked up are stored by address, addresses acting as objects of erasure are designated according to character sequence condition, and messages related to particular addresses can be erased collectively when the messages contain the designated character sequences.

In the same field of endeavor of selective call receiver, Murai teaches that wherein the message data which are picked up are stored by address, addresses acting as objects of erasure are designated according to character sequence condition, and messages related to particular addresses can be erased collectively when the messages contain the designated character sequences (column 3 line 43 to column 4 line 65) for the purpose of erasing the selectively stored messages.

One skill in the art would have recognized the need to modify the way to erase the messages in memory selectively by using the input section of Murai to the selective call receiver of Vanden Heuvel et al. in view of Katagiri because Vanden Heuvel et al. suggests that the need to erase the messages in memory selectively is so desired and Murai teaches that pager holder has preset the message-erasing time of "00:00," all message codes stored in the message memory, except for those containing a data-preserving flag, are automatically erased at the preset

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message-erasing time (column 10 lines 21 to 29). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the way to erase the messages in memory selectively by using the input section of Murai into the selective call receiver of Vanden Heuvel et al. in view of Katagiri with the motivation that a selective call receiver capable of erasing the collectively concerned messages of the user choice and providing the memory has more space to store other messages.

***Allowable Subject Matter***

Claims 1-24 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 571-272-3061. The examiner can normally be reached on Mon-Fri, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 571-272-3068. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nam Nguyen  
March 18, 2005

  
BRIAN ZIMMERMAN  
PRIMARY EXAMINER